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10/624,304	07/22/2003	Masafumi Matsuda	S01459.70053.US	7805

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Randy J. Pritzker
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210

EXAMINER	
LY, ANH	

ART UNIT	PAPER NUMBER
2162	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/624,304	MATSUDA ET AL.	
	Examiner	Art Unit	
	Anh Ly	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) *7 and 11-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-10 and 18-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 July 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *05/29/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is response to Applicants' AMENDMENT and filed RCE on 06/31/2007.

Request for Continued Examination (RCE)

2. The request filed on 06/21/2007 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/624,304 is acceptable and a RCE has been established. An action on the RCE follows.

3. Claims 7 and 11-17 cancelled.

4. Claims 1-6, 8-10 and 18-39 are pending in this application.

Response to Arguments

5. Applicant's arguments filed 06/31/2007 have been fully considered but they are not persuasive: for 101 rejection Claims 10 and 31-39 are rejected under 35 U.S.C. 101: software per se.

Applicant's arguments with respect to claim1-6, 8-10 and 18-39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10 and 31-39 are rejected under 35 U.S.C. 101 because the "computer-readable medium" is carrying signal due to not explicitly defined in the specification. So, these claims are signal per se, which is non-statutory subject matter.

Claimed Subject Matter Not in Specification

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "**Computer-readable medium**", "**first reproducing unit**" and "**second reproducing unit**" do not support in the **instant applicant's specification or even in the drawings**. Applicants are advised to amend the claims in a language that helps one of ordinary skills in the art to understand the intent of use and steps of invention. Applicant is reminded that no new subject matter should be added.

Drawings

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "11-1 and 11-2" has been used to designate both in fig. 1 and fig. 12. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet

submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Also, in fig. 1, fig. 4, fig. 9, fig. 13, fig. 18, fig. 19 and fig. 20 are missing the "label" for the "boxes".

9. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the drawings must be shown or the feature(s) claimed subject matter in claims 1, 9, 10 and 18 (such as a reproducing unit, a control unit, a reproduction status ... a list which shows said selected recommended content data, ...). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-6, 8-10 and 18-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0035692 A1 issued to Moriai in view of Pub. No.: US 2003/0191753 A1 issued to Hoch.

With respect to claim 1, Moriai teaches a data processing apparatus (fig. 1, distribution server, first cellular phone and second cellular phone, data processing apparatuses for receiving and transmitting data or music data from distribution server), comprising:

a reproducing means unit configured to reproduce a plurality of content data items (reproduction unit: section 0024, reproducing a plurality of music content data items: : section 0020);

a control unit configured to detect a reproduction status of each content data item when said each content data item is reproduced by said reproducing unit (each cellular phone has a control unit including detector unit for detecting reproducing processing including reproduction status of music content data item: sections 0024-0027, 0175 and 0180-0181),

and to select content data item from said plurality of content data items depending on a reproduction status of said content data item (selecting or outputting the content of music from a cellular phone: sections 0097 and 0159-0161); and

a communication unit configured to transmit to another data processing apparatus (from fig. 1, distribution server including data recording or reproducing device having a communicate unit for transmitting/distributing the music content data item to cellular phone: sections 0025, 0057 and 0060-0061).

Moriai teaches reproducing a plurality of music content data items and controlling and detecting reproduction status of music content data, selecting the music content data and transmitting or distributing the music content data. Moriai does not clearly

teach recommendation content data item and a list, which shows said selected content data item.

However, Hoch teaches transmitting and distributing and recommending the music content or song content and listing a list of songs (fig. 3D and sections 0063; also see sections 0023, 0026 and 0073).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Moriai with the teachings of Hoch. One having ordinary skill in the art would have found it motivated to utilize the use of recommending music content over network as disclosed (figs. 1 and 3D), into the system of Moriai for the purpose of distributing methods for recommending the music in order to make purchases and reflecting the user's personality, behaviors and habits, thereby, allowing the user to sort or select or rank the existing media based on their behaviors (Hoch's sections 0004-0005).

With respect to claims 2-6, Moriai teaches the data processing apparatus as discussed in claim 1. Also, Moriai teaches wherein said control unit detects the content data item having been reproduced longer than a predetermined time period (sections 0020, 0084 and 0149).

Moriai teaches reproducing a plurality of music content data items and controlling and detecting reproduction status of music content data, selecting the music content data and transmitting or distributing the music content data. Moriai does not clearly teach recommendation content data item.

However, Hoch teaches recommending the music content or song content and listing a list of songs (fig. 3D and section 0063).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Moriai with the teachings of Hoch. One having ordinary skill in the art would have found it motivated to utilize the use of recommending music content over network as disclosed (figs. 1 and 3D), into the system of Moriai for the purpose of distributing methods for recommending the music in order to make purchases and reflecting the user's personality, behaviors and habits, thereby, allowing the user to sort or select or rank the existing media based on their behaviors (Hoch's sections 0004-0005).

With respect to claim 8, Moriai teaches wherein said control unit searches for another data processing apparatus, and said communication unit transmits said list to said another data processing apparatus when said another data processing apparatus has been detected by said control unit (abstract, sections 0024-0027).

With respect to claim 9, Moriai teaches a data processing method for use with a data processing apparatus (fig. 1, distribution server, first cellular phone and second cellular phone, data processing apparatuses for receiving and transmitting data or music data from distribution server), the method comprising steps of:

reproducing a plurality of content data items (reproduction unit: section 0024, reproducing a plurality of music content data items: section 0020);

detecting a reproduction status of each content data item being reproduced (each cellular phone has a control unit including detector unit for detecting reproducing

processing including reproduction status of music content data item: sections 0024-0027, 0175 and 0180-0181);

selecting a content data item being reproduced from said plurality of content data items depending on a detected reproduction status of said content data item (selecting or outputting the content of music from a cellular phone: sections 0097 and 0159-0161); and

transmitting content data item to a second data processing apparatus (from fig. 1, distribution server including data recording or reproducing device having a communicate unit for transmitting/distributing the music content data item to cellular phone: sections 0025, 0057 and 0060-0061).

Moriai teaches reproducing a plurality of music content data items and controlling and detecting reproduction status of music content data, selecting the music content data and transmitting or distributing the music content data. Moriai does not clearly teach recommendation content data item and a list, which shows said selected content data item.

However, Hoch teaches transmitting and distributing and recommending the music content or song content and listing a list of songs (fig. 3D and sections 0063; also see sections 0023, 0026 and 0073).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Moriai with the teachings of Hoch. One having ordinary skill in the art would have found it motivated to utilize the use of recommending music content over network as disclosed (figs. 1 and 3D), into the

system of Moriai for the purpose of distributing methods for recommending the music in order to make purchases and reflecting the user's personality, behaviors and habits, thereby, allowing the user to sort or select or rank the existing media based on their behaviors (Hoch's sections 0004-0005).

Claim 10 is essentially the same as claim 9 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 9 hereinabove.

With respect to claim 18, Moriai teaches a data processing system having a first data processing apparatus and a second data processing apparatus (see fig. 1, distribution server, first cellular phone and second cellular phone, data processing apparatuses for receiving and transmitting data or music data from distribution server),

wherein said first data processing apparatus (first cellular phone user 1) comprises:

a first reproducing unit configured to reproduce a plurality of content data items (reproduction unit: section 0024, reproducing a plurality of music content data items: section 0020);

a first control unit configured to detect a reproduction status of each content data item being reproduced by at said reproducing unit (each cellular phone has a control unit including detector unit for detecting reproducing processing including reproduction status of music content data item: sections 0024-0027, 0175 and 0180-0181), and to select a content data item from said plurality of content data items depending on a

reproduction status of said content data item (selecting or outputting the content of music from a cellular phone: sections 0097 and 0159-0161); and

a first communication unit configured to transmit to the second data processing apparatus (from fig. 1, distribution server including data recording or reproducing device having a communicate unit for transmitting/distributing the music content data item to cellular phone: sections 0025, 0057 and 0060-0061);

wherein said second data processing apparatus (cellular phone user 2) comprises:

a second reproducing unit configured to reproduce a plurality of content data items; a second control unit configured to detect a reproduction status of each content data item being reproduced at said reproducing unit, and to select a content data item from said plurality of content data items depending on a reproduction status of said content data item; and a second communication unit configured to transmit to the second data processing apparatus (a second cellular phone as the same as the first cellular phone: reproduction unit: section 0024, reproducing a plurality of music content data items: section 0020; each cellular phone has a control unit including detector unit for detecting reproducing processing including reproduction status of music content data item: sections 0024-0027, 0175 and 0180-0181; selecting or outputting the content of music from a cellular phone: sections 0097 and 0159-0161; and from fig. 1, distribution server including data recording or reproducing device having a communicate unit for transmitting/distributing the music content data item to cellular phone: sections 0025, 0057 and 0060-0061).

Moriai teaches reproducing a plurality of music content data items and controlling and detecting reproduction status of music content data, selecting the music content data and transmitting or distributing the music content data. Moriai does not clearly teach recommendation content data item and a list, which shows said selected content data item.

However, Hoch teaches transmitting and distributing and recommending the music content or song content and listing a list of songs (fig. 3D and sections 0063; also see sections 0023, 0026 and 0073).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Moriai with the teachings of Hoch. One having ordinary skill in the art would have found it motivated to utilize the use of recommending music content over network as disclosed (figs. 1 and 3D), into the system of Moriai for the purpose of distributing methods for recommending the music in order to make purchases and reflecting the user's personality, behaviors and habits, thereby, allowing the user to sort or select or rank the existing media based on their behaviors (Hoch's sections 0004-0005).

With respect to claim 19, Moriai teaches wherein said communication unit communicates with another data processing apparatus via an ad hoc network (fig. 1; sections 0004-0006 and 0051-0053).

With respect to claim 20, Moriai teaches wherein said control unit transfers said list to a plurality of data processing apparatuses on said ad hoc network (fig. 1; sections 0004-0006 and 0051-0053; abstract, sections 0024-0027).

Claim 22 is essentially the same as claim 2 except that it is directed to the data processing method rather than the data processing apparatus, and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 23 is essentially the same as claim 3 except that it is directed to the data processing method rather than the data processing apparatus, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 24 is essentially the same as claim 4 except that it is directed to the data processing method rather than the data processing apparatus, and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 25 is essentially the same as claim 5 except that it is directed to the data processing method rather than the data processing apparatus, and is rejected for the same reason as applied to the claim 5 hereinabove.

Claim 26 is essentially the same as claim 6 except that it is directed to the data processing method rather than the data processing apparatus, and is rejected for the same reason as applied to the claim 6 hereinabove.

Claim 27 is essentially the same as claim 8 except that it is directed to the data processing method rather than the data processing apparatus, and is rejected for the same reason as applied to the claim 8 hereinabove.

Claim 28 is essentially the same as claim 19 except that it is directed to the data processing method rather than the data processing apparatus, and is rejected for the same reason as applied to the claim 19 hereinabove.

Claim 29 is essentially the same as claim 20 except that it is directed to the data processing method rather than the data processing apparatus, and is rejected for the same reason as applied to the claim 20 hereinabove.

Claim 30 is essentially the same as claim 21 except that it is directed to the data processing method rather than the data processing apparatus, and is rejected for the same reason as applied to the claim 21 hereinabove.

Claim 31 is essentially the same as claim 22 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 22 hereinabove.

Claim 32 is essentially the same as claim 23 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 23 hereinabove.

Claim 33 is essentially the same as claim 24 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 24 hereinabove.

Claim 34 is essentially the same as claim 25 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 25 hereinabove.

Claim 35 is essentially the same as claim 26 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 26 hereinabove.

Claim 36 is essentially the same as claim 27 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 27 hereinabove.

Claim 37 is essentially the same as claim 28 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 28 hereinabove.

Claim 38 is essentially the same as claim 29 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 29 hereinabove.

Claim 39 is essentially the same as claim 30 except that it is directed to at least one computer-readable medium rather than a data processing method, and is rejected for the same reason as applied to the claim 30 hereinabove.

Contact Information

12. Any inquiry concerning this communication or earlier communications from the examiner should directed to ANH LY, whose telephone number is (571) 272-4039 or via e-mail: ANH.LY@USPTO.GOV **(written authorization being given by Applicant(s) - MPEP 502.03 [R-2])** or fax to (571) 273-4039 (examiner's personal fax number).

The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Breene,** can be reached on **(571) 272-4107.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to:

Central Fax Center: (571) 273-8300

Cam y Thuong
primary Examiner

ANH LY
JUL. 6th, 2007